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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO. |
| 10/725,857   | 12/01/2003  | Sharon Lesk          | 7288-102/10312532           | 2832             |
| 167 7590 01/07/2011<br>FULBRIGHT AND JAWORSKI LLP<br>555 S. FLOWER STREET, 41ST FLOOR<br>LOS ANGELES, CA 90071 |             |                      | EXAMINER<br>GEHMAN, BRYON P |                  |
|  |             |                      | ART UNIT                    | PAPER NUMBER     |
|  |             |                      | 3728                        |                  |
|  |             |                      | NOTIFICATION DATE           | DELIVERY MODE    |
|  |             |                      | 01/07/2011                  | ELECTRONIC       |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/725,857 | <b>Applicant(s)</b><br>LESK ET AL. |  |
|                              | <b>Examiner</b><br>Bryon P. Gehman   | <b>Art Unit</b><br>3728            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2010 and 19 October 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,7-18,21-24 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7-9,12-18,21-24 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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1. Applicant's election of Invention I, the container, in the reply filed on October 19, 2010 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed by "the grooved ring having an outer wall and an inner wall (seen in the drawings), the outer wall being adjacent to the sidewall of the receptacle at a first distance above the closed bottom, the inner wall being at a second distance above the closed bottom, the second distance being less than the first distance" must be shown or the feature canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The replacement drawings were received on July 29, 2010. These drawings are not entered, as they are not deemed commensurate with the original disclosure, which describes nothing of the relation of height between the inner and outer walls, and indeed gives them no particular attention at all. Accordingly, adding this emphasis now would be new matter.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction, **but only if possible without introduction of new matter**, of the following is required: There is no apparent disclosure, nor is it clear what is meant by "the grooved ring having an outer wall and an inner wall (that much clearly seen in the drawings), the outer wall being adjacent to the sidewall of the receptacle at a first distance above the closed bottom, the inner wall being at a second distance above the closed bottom, the second distance being less than the first distance". Such has never been defined in the specification to any significant detail, nor is such a relationship ever clearly demonstrated in the drawings. Furthermore, should applicant be relying on the appearance of Figure 6, such is considered insufficient to provide the criticality of

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disclosure that applicants' now place thereon. While it may be considered the inner wall may appear lower in Figure 6, it is not definite from the original disclosure, as such was never clearly defined, and its reliance as the crux of applicants' invention at the time the invention was submitted is in doubt.

5. The amendment filed July 29, 2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: All disclosure added that now clearly relates to a height difference between the outer and inner walls. There is no clear basis for this height difference.

Applicant is required to cancel the new matter in the reply to this Office Action.

6. Claims 1-3, 5, 7-18, 21-24 and 27-29 are finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The original disclosure fails to provide support for the claim limitations of "the (detachable) grooved ring having an outer wall and an inner wall, the outer wall being adjacent to the sidewall of the receptacle having a top edge at a first distance above the closed bottom, the inner wall having a top edge being at a second distance above the closed bottom, the second distance being less

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than the first distance”, as set forth in claim 1, lines 9-12, and claim 8, lines 8-12. In claims 28 and 29, the insufficiently undisclosed structure is “the ring having a groove between an outer wall and an inner wall to hold liquid, the outer wall being adjacent to the sidewall of the receptacle and having a top edge at a first distance above the closed bottom, the inner wall having a top edge being at a second distance above the closed bottom, the second distance being less than the first distance” in claim 28, lines 7-11, and “the ring having a groove between an outer wall and an inner wall, the outer wall being adjacent to the sidewall of the receptacle, the inner wall having a top edge the top edge of the inner wall being below the top of the sidewall relative to the closed bottom” in claim 29, lines 7-10.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-2, 5, 7-9, 12-15, 18 and 22-24 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hinrichs (627,231) in view of Sakamoto (3,477,175). Hinrichs discloses a container or receptacle (A) adapted to be received in a motor vehicle drink holder (It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ

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138), the container or receptacle comprising a closed bottom (outer bottom surface of Hinrichs), a top with an opening and a sidewall that connects the bottom and the top, and a grooved ring (defined by B1 and B2) press fitted into the opening of the top, the grooved ring having an outer wall (B2) and an inner wall (B1), with the outer wall at a first distance above the closed bottom (bottom of B2 to the bottom of the flower pot directly vertically there below) and the inner wall at a second distance above the closed bottom (bottom of B1 to the bottom of the flower pot directly vertically there below), the second distance being less than the first distance. Hinrichs does not disclose a support means. However, Sakamoto discloses a plant stem support means (14) comprising a set of prongs (24) disposed in a plant stem receptacle. To modify the container of Ho employing the prongs of Sakamoto would have been obvious in order to support plant stems, as suggested by Sakamoto. "A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int 'l v. Teleflex Inc.*, 127 S. Ct. 1731, 82 USPQ2d at 1396. The variable whether the container or receptacle of Hinrichs being adapted to being received in a motor vehicle drink holder pertains to their size, and to any degree the container or receptacle of Hinrichs is not inherently sized corresponding to being received in a drink holder, to size either a container, receptacle or a drink holder sufficient to have the one fit in the other would have been obvious, as plant containers of a size to be capable of being received in a conventional drink holder have been long known in the art. A change in size is generally recognized as being within the level of ordinary skill in the art. See *In re Rose*, 105 USPQ 237 (CCPA 1955).

As to claims 5 and 8, Hinrichs discloses the ring as detachable and having a groove.

As to claim 7, the container of Hinrichs is inherently configured to stand on its own.

As to claim 8, the receptacle of Hinrichs is cup-shaped, as are all flower pots.

As to claims 12-15 and 22-23, Sakamoto disclose the supporting means (15) being removably connected at the bottom of its receptacle. However, applicants claim the relatively permanent and impermanent connections as being interchangeable. To provide an element as permanent or impermanent are the two options, and to render the element either would have been obvious to one of ordinary skill to obtain the desired permanence or removability.

As to claims 18 and 24, Hinrichs discloses a complete circumference ring.

9. Claims 1, 3 and 12-17 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hinrichs in view of Stone (2,057,856). Hinrichs discloses a container or receptacle (A) adapted to be received in a motor vehicle drink holder, the container or receptacle comprising a closed bottom, a top with an opening and a sidewall that connects the bottom and the top, and a grooved ring (defined by B1 and B2) press fitted into the opening of the top, the grooved ring having an outer wall (B2) and an inner wall (B1), with the outer wall at a first distance above the closed bottom (bottom of B2 to the bottom of the flower pot directly vertically there below) and the inner wall at a second distance above the closed bottom (bottom of B1 to the bottom of the flower pot directly



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vertically there below), the second distance being less than the first distance. Hinrichs does not disclose a support means. However, Stone discloses a plant stem support means comprising a frog (10) that is permanently connected to its container. To modify the plant container of Hinrichs employing the frog of Stone would have been obvious in order to support plant stems therein, as suggested by Stone.

As to claims 12, 14 and 16, Stone discloses the supporting means (10) being permanently connected to the bottom of the receptacle. To provide the supporting means as a permanent connection would have been obvious to maintain the supporting means with the receptacle. However, with respect to claims 13, 15 and 17, applicants claim the relatively permanent and impermanent connections as being interchangeable. To provide an element as permanent or impermanent are the two options, and to render the element either would have been obvious to one of ordinary skill to obtain the desired permanence or removability.

10. Claims 21 and 27 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the art as employed against claims 1 and 9 above and further in view of Holtkamp Jr. (5,477,640). Holtkamp discloses a detachable grooved ring (12 or between 14 and 22) disposed about the top of a plant and having a groove (containing air freshener 32 or containing 12 and 32) extending completely around the ring. To modify the plant container of the previous combination employing the ring with a groove as taught by Holtkamp Jr. would have been obvious in order to provide an air freshener capability to the plant container, as suggested by Holtkamp Jr..

11. Claims 28 and 29 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hinrichs. Hinrichs discloses a container comprising a receptacle (A), the receptacle comprising a closed bottom, a top with an opening and a sidewall that connects the bottom and the top, and a ring (defined by B1 and B2) sized to be press fit into the opening of the top, the ring having a groove between an outer wall (B2) and an inner wall (B1) capable to hold liquid, the outer wall adjacent the side wall of the receptacle, with the outer wall at a first distance above the closed bottom (bottom of B2 to the bottom of the flower pot directly vertically there below) and the inner wall at a second distance above the closed bottom (bottom of B1 to the bottom of the flower pot directly vertically there below), the second distance being less than the first distance. To render the receptacle “adapted to be received in a motor vehicle drink holder” would pertain to the sizing of the bottom portion (14). It has been long held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. See *In re Hutchison*, 69 USPQ 139. “When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has a good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product is not of innovation but of ordinary skill and common sense. In that instance, the fact that a combination was obvious to try might show it was obvious under 35 U.S.C. 103. *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1731, 82 USPQ2d at 1396. It would have

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been an obvious matter of design choice to provide the prior art container of a particular desired size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. See *In re Rose*, 105 USPQ 237 (CCPA 1955).

12. The affidavit under 37 CFR 1.132 filed July 29, 2010 is insufficient to overcome the rejection of claims 1-3, 5, 7-18, 21-24 and 27-29 based upon enablement as set forth in the last Office action because: The presence of some disclosure (description and enablement) in the original disclosure should evidence that applicant intended to claim or that applicant considered the material now claimed to be her invention. It is common that doubt arises about enablement because information is missing about one or more essential parts or relationships between parts which one skilled in the art could not develop without undue experimentation. In this case, there has never been any clear original disclosure that the outer wall and inner wall have different heights for any intended purpose. The applicant's claimed invention is based on the filed application, not on extraneous publications such as the cited brochures, as the lack of disclosure in the instant original specification indicates applicant did not intend the difference in height to be of her invention, or at least not worth mentioning.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

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13. Applicant's arguments filed July 29, 2010 have been fully considered but they are not persuasive. The examiner finds the height difference between the walls to be dubious at best from the original disclosure, certainly lacking for any basis of criticality of the invention, of which none was ever defined.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Tuesday through Thursday from 7:30am to 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Bryon P. Gehman/  
Primary Examiner, Art Unit 3728

/Mickey Yu/  
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BPG